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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/820,453

03/28/2001

Michael J. Borg

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10/04/2005

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HC

Office Action Summary

Application No.

09/820,453

Applicant(s)

BORG ET AL.

Examiner

Tamara L. Graysay

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 August 2005 has been entered.

The amendment filed 25 July 2005 and the supplementary amendment filed 16 September 2005 have been entered.

Claim Objections

2. Claims 7 and 8 are objected to because of the following informalities:
 - a. Claim 7 does not clearly distinguish the type of printing device from the first printing device that is the basis of the search criteria as defined by the search criteria in the searching step of claim 1, nor is the type of printing device related to the first printing device of claim 1. Therefore, claim 8 has been interpreted as further modifying both the retrieving and the searching steps such that the step of retrieving includes retrieving printing device data for a particular type of printing device (i.e., the first printing device as defined in claim 1). In other words, the type of printing device in claim 7 is the first printing device.
 - b. Claim 8 does not clearly distinguish the component of a particular type of printing device from the component used in a first printing device as defined by the search criteria in the searching step of claim 1. Therefore, claim 8 has been interpreted as further modifying both the retrieving step and the searching step such that the step of retrieving includes retrieving printing device data for a component of a particular type of printing device (i.e., the replaceable component on the first printing device as defined in claim 1). In other words, the component in claim 8 is the replaceable component and the particular type of printing device in claim 8 is the first printing device.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the step of searching the marketing database for a second printing device that meets certain search criteria. The search criteria being associated with the printing device data that was retrieved from the component memory on a replaceable component used in a first printing device. Thus, the process requires searching the marketing database for a second printing device that meets search criteria associated with the printing device data.

Claim 6 limits the search criteria to “a product that is used under a condition identified by the quality control data.” The quality control data identifies problems with certain products used under certain condition. This limitation is not commensurate with the limitation placed on the search criteria in claim 1. The claim scope is not particularly pointed out such that the metes and bounds of patent protection can be determined because the search criteria associated with the printing device data (the data retrieved from the replaceable component used in the first printing device) as required by claim 1, yet claim 6 limits the search criteria to a product used under a condition identified by the quality control data. Thus the claim is unclear whether the search criteria is to be associated with the printing device data as defined in claim 1 or whether the search criteria comprises a product identified by problems with products used under certain conditions. If claim 6 is further limiting the claim is unclear as to how the quality control data is used in relation to the second printing device searched for in the searching step of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (US-5789732) in view of Bullock (US-5835817).

Regarding claims 1, 2, 4, 5, and 7-11, McMahon discloses a method for retrieving data from the memory on a replaceable component (consumer card 10); storing the data in a marketing database (coupon generating system, col.4:10-42); associating the data with products (purchasing history of the consumer): searching the database for products (coupon and promotional discount opportunities for various products previously purchased that can be used in the current visit, col.4:19-22); and applying a predetermined marketing solution (download coupon and promotional discount opportunities that are redeemed at the point of sale, col.4:22-35). Generally, McMahon discloses a predetermined marketing solution or scheme using a memory card to retrieve information about a user's purchase history to market previously consumed goods or other goods associated with the previously consumed goods.

While McMahon is a memory on a replaceable component used for products in general, the memory is not specific to data associated with a component used in a first printing device.

Bullock teaches a memory on a replaceable component used in a first printing device (cartridge stores data on its memory chip, 7:55-60). This teaching is indicative of the printing art and the benefits of retaining printing device data on a component memory. Such benefits include avoiding the use non-compatible or counterfeit components in a printing device.

Art Unit: 3623

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McMahon to include information about print cartridge usage, such as suggested by the Bullock method, in order to ensure that a consumer receives an appropriate or predetermined marketing solution, i.e., appropriate coupon and promotional discounts based on the customer's use of a replaceable component. Applicant's method includes applying a marketing solution for a "second" printing device that meets certain criteria based on printing device data about a "first" printing device, i.e., a marketing strategy based on data about previously consumed products. The use of the descriptor first and second are not of particular importance insofar as the claim has not distinguished them from each other and the first and second printing device can be the same type of printing device. Alternatively, if the first and second printing devices are different, such a strategy is well known in the marketing field (at page 2 under MARKETING, the Magnet article, Who's winning the information revolution, describes an example of the marketing solution of using one product to recommend or entice a consumer to buy a different / compatible / substitute product based on prior consumption patterns).

Regarding claim 3, the data stored about the printing device in the McMahon and Bullock combination is an "environment" insofar as the information is about the use of the printing device and its component. The "environment," as broadly recited, is printing.

Art Unit: 3623

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (US-5789732) and Bullock (US-5835817), as applied to claim 1 above, and further in view of Burdick (US-5625816).

Burdick teaches a quality control data that permits users to improve quality based on the data about a particular device, element of a device, or production line. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the McMahon and Bullock combination to include a quality control data field, such as taught by Burdick, in order to improve the quality of the printer cartridge based on the data that is retrieved from the memory chip on the printer cartridge.

Response to Arguments

6. Applicant's arguments filed 25 July 2005 (entered per the Request for Continued Examination filed 26 August 2005) have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues at pages 9-10 that McMahon alone fails to teach or suggest the claim limitations. However, McMahon has been modified by a secondary reference, Bullock which is related to the replaceable printing component field. The combination and the rationale for combining the references is discussed in paragraphs 4 and 5 above.

Art Unit: 3623


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 9/27/05
Tamara L. Graysay
Examiner
Art Unit 3623

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